

REMARKS

RECOGNITION OF ALLOWABLE SUBJECT MATTER

Applicant acknowledges with gratitude the recognition that claim 3 represents allowable subject
5 matter.

CLAIM REJECTIONS UNDER 35 USC §112

Claims 3 through 8 stand rejected under 35 USC §112 for lack of clarity. Claim 1 has been amended to
10 recite "flexible substrate" and claims 6 and 7 have been amended to refer to "conductors" rather than conductive material.

CLAIM REJECTIONS UNDER 35 USC §102

15 Claims 1, 2 and 6 stand rejected under 35 USC §102 as being unpatentable over Humphrey. Amended claim 1 recites the use of a flexible substrate, something which is supported in the specification in many places including the summary, abstract and dependent claims.
20 Humphrey never mentions a flexible substrate. Although, Humphrey alternatively refers to the substrate 11 as being "silicon" or "silicone," (column 8, lines 57-58) the phrase "long, sharp, insulating silicone substrate 11" (emphasis added) indicates that he actually means to
25 refer to a rigid material, such as silicon, which in any event is more typically used as a substrate for photolithography. If substrate 11 were flexible it could not be driven through brain tissue. Accordingly, it cannot be said the Humphrey discloses a probe having a
30 flexible substrate as is recited in amended claim 1. Claims 2 and 6 are patentably distinct over Humphrey for at least the reason that their base claim is distinct.

CLAIM REJECTIONS UNDER 35 USC §103

Claims 1, 2 and 6 stand rejected under 35 USC §103 as being unpatentable over Kuperstein in view of Humphrey. Kuperstein, however, does not teach a probe
5 having a flexible substrate and, as discussed above, neither does Humphrey. Accordingly, the combination of these two references does not teach the flexible substrate recited in claim 1. As noted before, claims 2 and 6 are patentable at least because they depend on claim
10 1.

Applicant notes that the §103 rejection of claims 4, 5, 7 and 8 all depend on the Edell patent application, which claims priority back to May 30, 2001, under a 102(e) argument. A Declaration Under 37 CFR
15 1.131, swearing to an invention date earlier than the Edell priority date is submitted herewith. Applicant believes that this submission overcomes the rejection of claims 4, 5, 7 and 8 as an essential element of the combination putatively giving rise to obviousness has
20 been eliminated.

SPECIFICATION ISSUE

The PTO has stated, "page 9, line is vague." Although applicant is unsure of whether a specific line
25 was vague or, perhaps the line numbers, applicant is submitting page 9 again, which applicant hopes will resolve this issue.

DRAWINGS

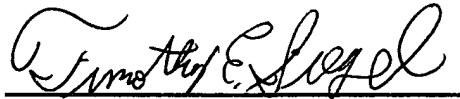
30 A substitute sheet 2 of 3 of the drawings is submitted, herewith, showing reference number "72."

It is respectfully submitted that the claims
are now in condition for allowance. Reconsideration and
early notice of allowance are respectfully solicited.

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Respectfully submitted,

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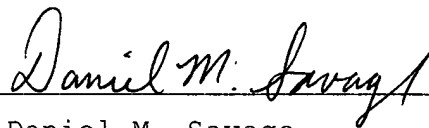
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In the embodiment of FIG. 6, electrodes 17 are from 12.56 square microns to 300 microns in surface area. In one preferred embodiment electrodes 17 are 176 have a surface area of 176 square microns. The probe 80, itself
5 is at least 5 mm long, and no more than 5 mm wide and 1 mm thick. In the preferred embodiment shown, cuts 48 are through-cuts and permit tissue ingrowth , which along with the tissue ingrowth at aperture 86 helps to anchor brain probe 90, in the brain tissue. In an alternative
10 preferred embodiment, cuts 48 are not present.

Referring to FIGS. 8, 9 and 10, the method of construction shown in FIGS. 5a-5g is used for the production of nerve cuffs 100, 110 and 120. A nerve cuff is a device that is adapted to be wrapped around a nerve
15 130 and used to electrically stimulate the nerve 130. In nerve cuff 110 a set of twelve contacts 112 have been created through photolithography. In nerve cuff 120 four complex contacts 122, designed for circumferentially contacting a nerve have been created by way of
20 photolithography.

The terms and expressions which have been employed in the foregoing specification are used as terms of description and not of limitation, and there is no intention, in the use of such terms and expressions, of
25 excluding equivalents of the features shown and described or portions thereof, it being recognized that the scope of the invention is defined and limited only by the claims which follow.